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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,091	09/04/2003	James J. LeKachman	47004.000216	5822
21967 7590 02/26/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
TRAN, HAI				
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3694				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/654,091

Applicant(s)

LEKACHMAN, JAMES J.

Examiner

HAI TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is the **Final Action** in response to the Amendments/Remarks filed by the Applicant on December 7, 2007.
2. Claims 1, 2, 4, 6, 8, 10-14, 16, 19, 22-25, 28, 29, and 31 have been amended. Accordingly, Claims 1-31 are pending in this application and have been examined.

Priority

3. This application claims the benefit of U.S. Provisional Patent Application No. 60/407,696, filed on 9/4/2002.

Drawings Objections

4. The drawings are objected to because figures 1 and 2 are not labeled with names (see figures 3 and 4 where the figures are labeled with numbers and names).
5. Appropriate correction is required.

Claim Objections

6. Applicant has amended claims 4 and 13; hence, the claim objection is withdrawn.

Claim Rejections - 35 USC § 112

7. Applicant has amended claims 1, 8, 9, 12 and the amendments overcome the rejection. Applicant has also clarified claims 3, 4, 10, 28, 29. Therefore, the rejection is withdrawn.

Response to Arguments

8. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Brody et al. (U.S. Patent Application Publication No. 2002/0077964) ("Brody")

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

11. **Regarding Claim 14**, Brody discloses a method for offering financial instruments to pre-qualified consumers (see paragraph 11), comprising:

a receiving information related to personal identification information of a consumer, the received consumer personal identification information being transmitted regardless of a request by the consumer to transmit the consumer personal

identification information (see paragraphs 62, 64, figure 3 where it says "According to one aspect of the invention, the system of the present invention can request credit reports from any credit bureau");

inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with a financial institution (see paragraphs 68-73, figure 4/elements 116-132); and

offering the consumer the financial instrument for which he or she is pre-qualified, if the third party confirms that the consumer is pre-qualified for a financial instrument (see paragraph 74, figure 4/elements 132-138),

wherein the third party maintains consumer information relating to consumer pre-qualification for financial instruments, wherein further the standards for the consumer pre-qualification are set by the financial institution (see paragraph 12 where it says "an offer from a merchant with merchant define criteria" and "based at least partially on the criteria provided by the merchant", and paragraph 72, figure 4/element 128).

12. **Regarding Claim 15**, Brody teaches the method of claim 14, wherein pre-qualification of the consumer comprises checking at least one of the credit rating of the consumer, the income level of the consumer, the debt level of the consumer and the payment history of the consumer with the financial institution (see paragraph 64).

13. **Regarding Claim 16**, Brody teaches the method of claim 15, wherein pre-qualification of the consumer occurs prior to receipt of the consumer personal

identification information (see paragraph 7 where it says "the consumers are anonymous to the merchants").

14. **Regarding Claims 17-18**, Brody teaches wherein the third party maintains consumer information in files indexed by a unique identifier, and wherein the unique identifier relates to the personal identification information of the consumer (see paragraphs 6 where it says "through a trusted third party agent", "maintain the data in confidentiality", 8-9 where it says "creating an account with the consumer").

15. **Regarding Claim 19**, Brody teaches the method of claim 18, further comprising offering the financial instrument to the consumer only if the consumer credit rating meets or exceeds a pre-determined condition (see paragraphs 6 where it says "receive merchant criteria for pre-approved offer and identify to consumers those merchants offers for which the consumer has been pre-approved", 12 where it says "offer from a merchant with merchant define criteria").

16. **Regarding Claims 20-21**, Brody teaches wherein the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive, and wherein the financial instrument comprises at least one of a car loan, boat loan, loan on investment property, margin account, business loan, second mortgage, home equity line of credit, consumer loan, transaction card, credit card, loyalty card, co-branded credit card, debit card, rewards card, smart card, mutual fund or insurance (see paragraphs 68-69).

17. **Regarding Claim 22**, Brody teaches the method of claim 21, wherein the consumer is offered the financial instrument only if one or more pre-determined conditions are met (see paragraph 12).

18. **Regarding Claims 23-25**, Brody teaches wherein the consumer personal identification information is obtained when the consumer makes contact comprises a purchase from a merchant, wherein the consumer personal identification information is obtained through contact comprises one of a communication from a business partner of the financial institution or a communication directly to the financial institution, and wherein consumer personal identification information is obtained through a telephone call or contact over a computer network (see paragraphs 50+).

19. **Regarding Claim 26**, Brody teaches the method of claim 25, further comprising offering the financial instrument only upon the acceptance of any terms and conditions related to the financial instrument by the consumer (see paragraphs 77, 78).

20. **Regarding Claim 27**, Brody teaches the method of claim 25, further comprising offering the financial instrument to the consumer only if the identity of the consumer is authenticated (see paragraph 68, figure 4/element 116).

21. **Regarding Claims 28-29**, Brody teaches wherein authenticating the consumer comprises favorable comparison of stored consumer information to consumer personal identification information, and wherein the consumer personal identification information comprises at least one of a calling telephone number, a PIN, a password, a biometric or any other information known or held by the consumer and generally not known to the public that can be used to authenticate the consumer (see paragraphs 34, 43, 54-56)

22. **Regarding Claim 30**, Brody teaches the method of claim 28, wherein authentication is performed by the third party (see paragraph 7).
23. **Regarding Claim 31**, this claim is similar to claim 14 except that “wherein further the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive” (see discussion in claim 20-21 above).
24. **Regarding Claims 1-13**, these are the computer system claims including the necessary apparatus, programs, and processors for implementing the method claims 14-31 and have the same limitations. Hence, they are rejected under the same rationale provided in claims 14-31.

Conclusion

25. Claims 1-31 are rejected.
26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364.

The examiner can normally be reached on M-F, 9-4 PM.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. T./

Examiner, Art Unit 3694

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694